

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISANORI NAKAJIMA, IAN CLARKE,
and MASA HIDRO HIDROSE

Appeal 2007-0975
Application 09/240,695
Technology Center 2100

Decided: May 21, 2007

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and MAHSHID D. SAADAT, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-17. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal previews data that are to be printed. According to the Appellants, a host computer generally performs part of a printing process. For example, the host computer converts data based on a print request input from an application program ("AP") into print control code readable by a printer, spools the print control code, and sends "despoled," i.e., "inversely spooled," print control data to the printer. (Amendment of June 3, 2002 at 2.) Because independent tasks write the print control code into, and read the print code out of, a spool file, the spooling minimizes a waiting period that would otherwise result from any difference between the speed of sending the print control code to the printer and the speed of printing. (Specification 1.)

The Appellants explain that added-value information, such as control codes for printing a watermark or a stamp mark, are often added to a print control code. A "watermark" is a character that is "overlappingly printed in the background of printed characters or the like that are printed in accordance with instructions of the AP, in a color or a display form which is different from that of the printed characters." (*Id.*) "A 'stamp mark' is a mark which is similar to a conventional stamp." (*Id.*) "In related arts," add the Appellants, "once the AP gives a print request or the host computer adds added-value information to the printing device, the user cannot check the finished condition of the actual printing before printing is actually output from the printing device." (*Id.* 1-2.)

In contrast, the Appellants' invention enables print data to be checked visually and edited immediately before printing. (Amendment of June 3, 2002 at 1.) More specifically, a data converter 14 converts a spooled print control code into data that are displayed to a user. If the user wishes to edit the data, he designates a region to be edited and inputs a change. A data edit controller 15 alters display data in accordance with the change. A data inverse converter 16 converts the changed display data into the structure of the original print control code and restores the converted data into a spool file 13. A despooler 17 reads out the restored print control code, which is transferred to a printer via a "transfer controlling means." (Specification 13.)

B. CLAIMS

Claims 1, 3, and 11, which further illustrate the invention, follow:

1. A method for previewing a print data, comprising the steps of:

obtaining print data which can be printed by a printing device, and spooling the print data into a predetermined memory;

converting the spooled print data into display data of a predetermined structure, and displaying the display data on a displaying device;

editing the display data which is being displayed, on the basis of an edit instruction data which is input at the display; and

inversely converting the edited display data into a structure of the spooled print data,

wherein, the display data contains template data that is subjected to the editing, and at least a type and a position of the template data are capable of being edited via the editing.

3. A method for previewing a print data, comprising the steps of:

obtaining print data which can be printed by a printing device, and spooling the print data into a predetermined memory;

converting the spooled print data into display data of a predetermined structure, and displaying the display data on a displaying device;

editing the display data which is being displayed, on the basis of an edit instruction data which is input at the display;

wherein, when the print data consists of actual print information based on a print request and added-value information which is posteriorly added, said step of editing the display data uses only the added-value information which is being displayed, as an edited object; and

inversely converting the edited display data into a structure of the spooled print data,

wherein the added-value information includes at least template data.

11. A computer-readable medium on which program codes are recorded, wherefore said program codes are read and executed by a computer device, being connected to a printing device, having input means for a data entry and a displaying device,

with causing said computer device to perform the following processes:

(1) a spool process of spooling print data which can be printed by said printing device;

(2) a data conversion process of converting the spooled print data into display data of a predetermined structure,

(3) a display control process of displaying the converted display data on said displaying device;

(4) a data edition process of editing the display data which is being displayed, on the basis of edited data which is input at the display of said displaying device, through said input means;

wherein said data edit process is a process of detecting an object added to the print data and editing contents of the object on the basis of an instruction; and

(5) data inverse conversion process for inversely converting the edited display data into a structure of the spooled print data.

C. REJECTION

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,671,345 ("Lhotak") and Japanese Patent Application No. 09-198217 ("Tokiwa").

II. ARGUMENTS NOT CONSIDERED

"[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in . . . the principal brief[]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee." *Kaufman Company*,

Inc. v. Lantech, Inc., 807 F.2d 970, 973 n., 1 USPQ2d 1202, 1204 n. (Fed. Cir. 1986). "Considering an argument advanced for the first time in a reply brief . . . is not only unfair to an appellee . . . but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered." *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted).

Here, the Appellants' Reply Brief presents new arguments regarding the Examiner's reason "to include the feature of Tokiwa in Lhotak. . . ." (Reply Br. 4.) Because the Examiner explained the reason for such inclusion in her Final Rejection (p. 4), the Appellants could have made the arguments concerning the reason in their original brief. They chose not to do so.

The term "Reply Brief" is exactly that, a brief in reply to new rejections or new arguments set forth in an Examiner's Answer. The Appellants may not present their arguments in a piecemeal fashion, holding back arguments until an examiner answers their original brief. Of course, the Appellants may present new arguments directly to the Examiner for consideration as part of a continuing application.

III. CLAIMS 1, 2, 7-12, AND 17

Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween. The Examiner admits, "Lhotak does not specifically teach . . . the display data contains template data that is subjected to the editing, and at least a type and a position of the template are capable of

being edited via the editing." (Answer 6.) He alleges, however, "Tokiwa teaches . . . the display data contains template data (*PDL interpreter 14*) that is subjected to the editing, and at least a type and a position of the template are capable of being edited via the editing (*the data form . . . are converted from the PDL form; ¶0026*)." *(Id.)* The Appellants argue that "the PDL interpreter 14 of Tokiwa resides in the printer 10 and is a device that transforms data formats. Thus, the PDL interpreter 14 is not contained in the RGB data and therefore fails to teach or suggest the claimed template data." *(Reply Br. 5.)* Therefore, the issue is whether Tokiwa teaches the capability to edit the type and position of displayed data.

A. CLAIM CONSTRUCTION

Our analysis begins with construing the claim limitations at issue. "The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, independent claims 1, 7, 10, and 17 recite in pertinent part the following limitations: "the display data contains template data that is subjected to the editing, and at least a type and a position of the template data are capable of being edited via the editing." Considering all the limitations, the independent claims require the capability to edit the type and position of displayed data.

B. OBVIOUSNESS ANALYSIS

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004).

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)).

"A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, in Tokiwa, "[p]rinted data described in page description languages (PDL) are stored in a printed data storage 18 via a PDL interpreter 14 and a device color space conversion part 16." (Tokiwa Translation 1.¹) The paragraph of Tokiwa cited by the Examiner discloses that data to be printed "are at first sent to the PDL interpreter 14, and the data form thereof are converted from the PDL form into a data form particular to the present device." (*Id.* 4.) Agreeing with the Appellants that

¹ We refer to the page numbers of the "partial translation[]" submitted by the Appellants. (Information Disclosure Statement of Nov. 10, 2004 at 2.)

"the PDL interpreter 14 is a device that transforms data formats," (Reply Br. 5), we are uncertain how the Examiner equates the device to displayed data. We are likewise unpersuaded that the conversion of data, which is to be printed, from the PDL format into a device-specific format constitutes the editing of the type and position of displayed data.

Absent a teaching or suggestion of the capability to edit the type and position of displayed data, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 1, 7, 10, and 17 and of claims 2, 8, 9, and 12, which depend therefrom.

IV. CLAIMS 3-6 AND 13-16

The Examiner alleges, "Tokiwa teaches wherein, when the print data consists of actual print information based on a print request and added-value information which is posteriorly added, the step of editing the display data uses only the added-value information which is being displayed, as an edition object (¶ 0030)." (Answer 7-8.) The "Appellants submit that claims 3 and 13 are patentable for at least analogous reasons as set forth above for claim 1." (Appeal Br. 14.) Therefore, the issue is whether Tokiwa teaches editing only displayed added-value information that were added to data for which printing was requested, the addition occurring after the request for printing.

A. CLAIM CONSTRUCTION

Independent claims 3 and 13 recite in pertinent part the following limitations: "when the print data consists of actual print information based

on a print request and added-value information which is posteriorly added, said step of editing the display data uses only the added-value information which is being displayed, as an edited object. . ." Considering all the limitations, the independent claims require editing only displayed added-value information that were added to data for which printing was requested, the addition occurring after the request for printing.

B. OBVIOUSNESS ANALYSIS

"A rejection based on section 103 clearly must rest on a factual basis. . ." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). "The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *Id.*

Here, the paragraph of Tokiwa cited by the Examiner describes "various kinds of functions," (Tokiwa Translation 5), of a "color correction part 22." (*Id.*) The Examiner, however, has not explained what in the paragraph, if anything, constitutes added-value information. We will not resort to speculation, unfounded assumptions, or hindsight reconstruction to supply the explanation.

Absent a teaching or suggestion of editing only displayed added-value information that were added to data for which printing was requested, the addition occurring after the request for printing, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 3 and 13 and of claims 4-6 and 14-16, which depend therefrom.

V. CLAIM 11

The Examiner makes the following allegations.

Tokiwa's teaching "*when S108 detects that the content of color correction is input, S109 changes the color as designated for the printed data of the object of color correction . . . the color correcting functions for converting from RGB to R 'G 'B,' and a basis model shown in (A) which does not carry out the substantial color correction is changed [b]y interlocking the user's input*" [see Tokiwa, ¶0038] meets "*detecting an object added to the print data*" as claimed by Appellant.

(Answer 13.) The Appellants argue that "the only 'detection' performed in Tokiwa is the detection that a color correction was input in step S108. Such input is the initial instruction or request to correct the color." (Appeal Br. 15.) Therefore, the issue is whether Tokiwa teaches detecting an object added to the print data and editing contents of the object based on an instruction.

A. CLAIM CONSTRUCTION

Claim 11 recites in pertinent part the following limitations: "wherein said data edit process is a process of detecting an object added to the print data and editing contents of the object on the basis of an instruction. . . ." Considering all the limitations, the claim requires detecting an object added to the print data and editing contents of the object based on an instruction.

B. OBVIOUSNESS ANALYSIS

Here, the paragraph of Tokiwa cited by the Examiner describes "the operations of the color correction part. . . ." (Tokiwa Translation 14.) More

specifically, "when S108 detects that the content of color correction is input, S109 changes the color as designated for the printed data of the object of color correction selected similarly. . ." (*Id.* 10.) Although the operation includes detecting, it is not detect an object added to the print data. To the contrary, we agree with the Appellants that it merely detects "that a color correction was input. . ." (Appeal Br. 15.)

Absent a teaching or suggestion of detecting an object added to the print data and editing contents of the object based on an instruction, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claim 11.

VI. CONCLUSION

For the aforementioned reasons, the rejection of claims 1-17 under § 103(a) is reversed.

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REVERSED

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